18 will be pending in this application. The amendment to the claims does not add any new matter.

1. Affirmation of election of Group I

Applicants respectfully affirm the telephonic election of Group I, with traverse.

Applicants believe that a proper search for the subject matter contained in each individual group is germane to the subject matter contained in all groups as a whole. Thus, no "lack of unity" of invention is present. However, solely to remove the basis for the restriction and to prevent an objection to the claims for containing non-elected subject matter, applicants have deleted the subject matter of Group II (i.e., formula (b) and the substituent definitions contained in formula (b)) from the claims without prejudice or disclaimer. Applicants reserve the right to file divisional applications directed to the restricted out subject matter.

2. Rejection of claims 17-18 under 35 U.S.C. §112, 1st paragraph

The Examiner has rejected claims 17-18 under 35 U.S.C. §112, 1st paragraph as being non-enabled because "the specification...does not reasonably provide enablement for in vivo treatment of an illness treatable by PDE4 inhibition (claim 17)

or of an airway disorder".

RESPONSE

Applicants respectfully traverse this rejection. The present specification would enable a person of skill in the art to practice the claimed invention according to currently amended claims 17 and 18.

Claim 17 has been amended to recite a method of treating bronchial asthma, COPD or allergic rhinitis by administering the presently claimed compound of claim 1. Thus, claim 17 is not longer directed to a method of treating any illness "treatable by the administration of a PDE4 inhibitor".

Claim 18 has been amended to recite a method of treating psoriasis or atopic eczema by administering the presently claimed compound of claim 1. As such, claims 17-18 have been significantly narrowed and applicants respectfully submit that these claims are fully enabled by the present specification. No undue experimentation would be required to practice the presently claimed invention.

Applicants respectfully point out to the Examiner that the specification must be taken together with the knowledge of a person of skill in the art at the time the invention was made. In particular, the "State of the Prior Art" is one of the Wands factors which may determine what type of experimentation is

considered to be "undue". In this regard, applicants have filed herewith several additional references in an Information Disclosure Statement which comment on what was known in this particular art area even before the present application was filed. In particular, two references have been cited which support applicants position that the presently pending claims 17 and 18 are fully enabled by the specification.

In short, applicants have demonstrated through the data in Table 1 on page 34 that a selection of the Example compounds inhibit PDE4 activity. Further, applicants have claimed in claims 17 and 18 that the compounds of claim 1 may be used to treat 5 specific disorders. Finally, the references show that administration of a PDE4 inhibitor may be used in the treatment of these specific disorders. As such, these IDS references provide a nexus between the concept of PDE4 inhibition and treatment of a particular disease.

Applicants first point to the Grootendorst, et al. reference. This reference clearly demonstrates that PDE4 inhibitors may be successfully used in the treatment of the disorders presently claimed in claim 17 - allergic rhinitis, COPD and bronchial asthma. In particular, the Grootendorst, et al. reference teaches in the introduction that one PDE inhibitor, theophylline "has been used in the management of

asthma and (COPD) for more than 70 years." Grootendorst, et al. further teach that "a variety of different PDE4 inhibitors has been described and extensively studied in in-vitro models and animal settings" with some of the results being "very promising" and several PDE4 inhibitors passing safety studies and undergoing Phase II and III clinical studies in the treatment of allergic rhinitis, asthma and COPD.

Further, the Souness, et al. reference also teaches the use of PDE inhibitors in the treatment of asthma and COPD. In particular, at page 141, Souness, et al. teach that "[w]hile most pharmaceutical companies in the PDE4 field have targeted asthma, recent clinical results … suggest considerable potential for PDE4 inhibitors in the treatment of COPD." Further, on page 144 of Souness, et al., Table 6 outlines no fewer than 10 PDE4 and PDE3/4 -inhibitors which have been tested in asthma and/or COPD models. On page 145, it is observed by the authors that "Phase III clinical trials in COPD patients [with a PDE4 inhibitor] are ongoing and the results are awaited with interest."

As such, the Grootendorst, et al. and Souness, et al. references provide the nexus between PDE4 inhibition and treatment of the disorders presently claimed in claim 17 - bronchial asthma, COPD and allergic rhinitis. Since applicants

have demonstrated that the presently claimed compounds inhibit PDE4 activity, it would not require a person of ordinary skill in the art to undertake undue experimentation to practice the presently claimed invention. Thus, claim 17 is fully enabled.

Regarding claim 18 directed to the treatment of psoriasis and atopic eczema, Souness et al. teach on page 148, section 10, entitled "Potential of PDE4 inhibitors in dermatological disorders", that PDE4 inhibiting "compounds have been evaluated with some success in patients with dermatological complaints such as atopic dermatitis (AD) and psoriasis." Also, at Table 6 (pg. 144), Souness et al. show that Atizoram (CP-80633) is used to treat the inflammatory disease atopic dermatitis. Souness et al., in section 8.2, also teach "Ro 20-1724 and CP-80633 demonstrate some efficacy when applied topically to AD patients. For example, atizoram, when applied as a topical ointment (0.5%) over 28 days to affected areas in 20 AD patients, demonstrated efficacy with significant reductions in all inflammatory parameters measured."

As such, the Souness, et al. reference clearly shows that a person of ordinary skill in the art would be enabled by the present specification by demonstrating a nexus between PDE4 inhibition and the treatment of the two disorders presently claimed in claim 18 - atopic eczema and psoriasis. Since

applicants have demonstrated that the presently claimed compounds inhibit PDE4 activity, it would not require a person of ordinary skill in the art to undertake undue experimentation to practice the presently claimed invention. Thus, claim 18 is fully enabled.

Accordingly, applicant respectfully requests that the Examiner reconsider and withdraw this rejection of claims 17-18.

3. Rejection of claims 1-13, 15, 17 and 18 under 35 U.S.C. §112, 2nd paragraph

The Official Action states that claims 1-13, 15, 17 and 18 are rejected under 35 U.S.C. §112, 2nd paragraph as being indefinite.

RESPONSE

Applicants respectfully traverse this rejection. The claims are perfectly clear when read in light of the present specification.

The Examiner has stated that it is not understood what is meant by "completely or predominantly substituted by fluorine" in claim 1. Applicants respectfully point out to the Examiner that page 4, paragraph 3 of the specification clearly defines the term "predominantly" with the following statement: "'Predominantly' in this connection means that more than half of

the hydrogen atoms of the 1-4C-alkoxy group are replaced by fluorine atoms." As such, applicants have "particularly pointed out and distinctly claimed" this subject matter.

The Examiner also has stated that "it is not understood what is intended by a 'hydrocarbon ring, optionally interrupted by an oxygen or a sulphur atom'." Applicants respectfully point out to the Examiner that this language has been deleted from the claims without prejudice or disclaimer due to the cancellation of subject matter related to formula (b) as discussed above.

The Examiner also has stated that the reference to "PDE4" in claims 17 and 18 is not clear. Applicants respectfully point out to the Examiner that this term is no longer in claims 17 and 18 due to the amendment of these claims to recite specific disorders.

Accordingly, applicant respectfully requests that the Examiner reconsider and withdraw this rejection of claims 1-13, 15 and 17-18.

4. Rejection of claims 1-13, 15 and 17-18 under 35 U.S.C. §103

The Official Action states that claims 1-13, 15 and 17-18 are rejected under 35 U.S.C. §103(a) over WO 2004018451 to Hatzelmann, et al.

RESPONSE

Applicants respectfully traverse this rejection. The Examiner is correct that the Hatzelmann, et al. reference is only available as prior art under 35 U.S.C. §102(e). Since the present application is commonly owned with the Hatzelmann, et al. application, this reference is disqualified as prior art under 35 U.S.C. §103(c).

Accordingly, applicants respectfully request that the Examiner reconsider and withdraw this rejection of claims 1-13, 15 and 17-18.

CONCLUSION

If the Examiner has any questions or wishes to discuss this matter, the Examiner is welcomed to telephone the undersigned attorney.

Respectfully submitted,
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